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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/707,671

11/07/2000

Umesh J. Amin

2000-0107

9709

34700

7590

07/02/2004

DOCKET CLERK  
P.O. BOX 802432  
DALLAS, TX 75380

EXAMINER

PEREZ GUTIERREZ, RAFAEL

ART UNIT

PAPER NUMBER

2686

13

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/707,671

Applicant(s)

Amin et al.

Examiner

Rafael Perez-Gutierrez

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 and 28-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-27 and 41-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4 and 12</u> . | 6) <input type="checkbox"/> Other: ____.  |

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### **DETAILED ACTION**

1. This Action is in response to Applicant's response to restriction requirement filed on October 22, 2003. **Claims 1-52** are still pending in the present application. **This Action is made NON-FINAL.**

#### ***Election/Restriction***

2. Applicant's election with traverse of Invention I, **claims 1-7, 12-27, and 41-52** in the reply filed on October 22, 2003 is acknowledged. The traversal is on the ground(s) that Invention I and Invention II are not independent. This is found not persuasive because Invention I does not require, for example, the use of the menu driven service selection of Invention II and, consequently, Invention II differs from Invention II in both, design and operation, and accordingly, they are independent from each other. The requirement is still deemed proper and is therefore made FINAL. **Claims 8-11 and 28-40** are withdrawn from further consideration pursuant as being drawn to a nonelected invention.

#### ***Priority***

3. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

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***Information Disclosure Statement***

4. The information disclosure statements submitted on November 7, 2000 and June 7, 2004 have been considered by the Examiner and made of record in the application file.

***Drawings***

5. New formal drawings are required in this application. See the attached Notice of Draftsperson's Patent Drawing Review for appropriate corrections.

6. **Figure 1B** should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

7. Corrected drawing sheets are required in reply to the Office Action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office Action. If a response to the present Office Action fails to include proper drawing corrections, corrected drawings or arguments therefor, the response can be held **NON-RESPONSIVE** and/or the application could be **ABANDONED** since the corrections to the drawings are no longer held in abeyance.

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***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 1-7, 12-27, and 41-52** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Findikli et al. (U.S. Patent # 6,529,727 B1)** in view of **Dusse et al. (U.S.**

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**Patent # 6,647,260 B2).**

Consider **claims 1, 5, 6, 18, and 42**, Findikli et al. clearly show and disclose a mobile communication device, a programmable module (SIM) 50 (figure 1) for use with a mobile communication device and a method for activating a mobile communication device in a wireless network (abstract) comprising:

establishing a transmission link between said mobile communication device and the wireless network (figure 6 and column 5 lines 49-54);

said mobile communication device receiving, via said the transmission link, at least one assigned operating parameter (IMSI) (figure 6 and column 6 lines 4-34); and

storing said at least one assigned operating parameter in a memory element associated with said mobile communication device (column 6 lines 32-34).

However, Findikli et al. do not specifically disclose that the transmission link is a wireless packet data transmission link (PDP context).

Dusse et al. clearly show and disclose a method for activating a mobile communication device via a wireless packet data transmission link between said mobile communication device and a wireless network (column 3 lines 25-50 and column 4 lines 3-44).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to activate the mobile communication device via a data link as taught by Dusse et al. in the method of Findikli et al. for the purpose of providing activation services for additional wireless architectures such as GPRS (Findikli et al; column 4 lines 23-25).

Consider **claims 2, 12, 15-17, 19, 21, 22, 25, 41, 43, and 44**, and **as applied to claims 1,**

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**18, and 42 above**, Findikli et al. further disclose that said memory element initially contains at least one temporary operating parameter that facilitates operation of said mobile communication device in an activation mode (column 5 lines 54-63).

Consider **claims 3, 13, 14, and 23**, and **as applied to claims 2 and 12 above**, Findikli et al. also disclose that said storing step replaces said at least one temporary operating parameter with said at least one assigned operating parameter (column 6 lines 4-40).

Consider **claims 4, 20, 24, 26, and 45-52**, and **as applied to claims 2, 19, 22, and 44 above**, Findikli et al. further disclose the step of transmitting an attach request using said at least one temporary operating parameter (figure 6 and column 5 lines 36-54).

Consider **claims 7 and 27**, and **as applied to claims 1 and 22 above**, Dusse et al. disclose transmitting, via wireless packet data communication link, information indicative of a number of service features selected by a user of said mobile communication device (abstract, figure 2, column 2 lines 4-51, and column 3 lines 25-50).

### ***Conclusion***

10. Any response to this Office Action should be **faxed to (703) 872-9306 or mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Hand-delivered responses** should be brought to

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Crystal Park II  
2021 Crystal Drive  
Arlington, VA 22202  
Sixth Floor (Receptionist)

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (703) 308-8996. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700 or call customer service at (703) 306-0377.

  
Rafael Perez-Gutierrez  
R.P.G./rpg

**RAFAEL PEREZ-GUTIERREZ**  
**PATENT EXAMINER**

June 25, 2004